

### **Remarks**

The application has been carefully read and no typographical errors have been found.

The Examiner errs that the term “relies” is incorrect. The statement reads “compositions ... rely”. The term “relies” would be used if “compositions” was singular.

The Examiner further errs that this information of serial no. 09/637,263 is incorrect. As seen from the attached, the application is that of the cited patent no. 6,602,834.

The Examiner is further incorrect in the belief that patent no. 6,602,834 is essential to the present invention. The patent merely identifies the background of the invention and is not at all pertinent as will be hereafter discussed.

Claim 10 has been amended to state that the remainder of the composition is an inert polar solvent.

### **The Rejection Under 35 USC 102**

Reconsideration is respectfully requested of the rejection of the claims under 35 USC 102(a) as being anticipated by Ward '834.

Ward '834 relates to a particle repulsive cutting and lubricating composition in which ionized surfactants and electrolytes have the same charge so as to result in electrostatic van der waals and steric repulsion which keeps the articles in suspension. An important feature is that the electrolytes are neutralized. The neutralization is in situ. Without the neutralization the system does not work.

In the present invention, surfactants and polyelectrolytes are not used.

Ward '834 does not use water. However, water in the present invention is essential.

The Examiner considers that the polyelectrolytes of Ward '834 correspond to the suspending particles of the invention. However, the polyelectroparticles of Ward '834 are organic while the suspended particles of the present invention are inorganic.

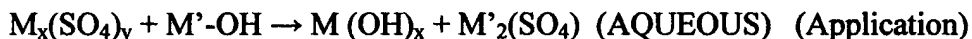
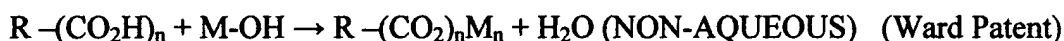
The Examiner states that iron salts such as nitrates and sulfates are oxidizing agent. The Examiner in this regard is in error. Iron nitrates and sulfates are not oxidizing agents.

It should be noted that the polyelectrolytes of Ward '834 can only be used in non-aqueous systems. The reference clearly states that more than 10% water cannot be used. In contrast, the present invention provides for up to 99% water. In Ward '834 if the water content exceeds more than about 10%, the polyelectrolyte gels dissolve and the carrier is useless.

The suspension particles of the present invention are not ionic in nature and have nothing to do with electrostatic repulsion and operate strictly by physiochemical interference.

Consequently, there can be no anticipation by Ward '834. In order to constitute an anticipation under Section 102, it is an absolute requirement that the prior patent bear within its four corners directions for the practice of the present invention (see Kalman v. Kimberly Clark Corp., 218 USPQ 789 (Fed. Cir. 1983)).

The differences between Ward '834 and the present invention can be seen by the differences in the reaction mechanisms.



Reconsideration is respectfully requested of the rejection of the claims under 35 USC 103 as being unpatentable over Ward in view of Canaperi et al.

The Examiner alleges that the slurry compositions of Canaperi et al are essentially the same as those of "Ward" since it comprises about 10 to 50 g/liter of an oxidizing agent. The Examiner is in complete error in this regard and demonstrates the patentable distinction of the present invention over the prior art. Neither Ward '834 or the present invention disclose an oxidizing agent. Moreover, Ward clearly states that the polyelectrolytes must be neutralized with a Bronsted base. Canaperi does not specify neutralization and the present invention does not utilize any polyelectrolytes. Consequently, there are three separate and distinct inventions which teachings cannot be combined and the prior art is totally irrelevant to the present invention.

The Examiner states, "The slurry of the invention is preferably an aqueous slurry". If the Examiner is referring to the present invention she is again in error. The present invention does not relate to a slurry but a carrier system. The function of the carrier is to suspend abrasive particles for long periods of time without settling. Also

neither Ward '834 or the present invention relate to oxidizing agents. As previously stated, iron salts such as sulfates and nitrates are not oxidizing salts.

The combination of Ward '834 and Canaperi et al is not compatible and cannot be used to arrive at the present invention. Ward '834 does not teach or suggest the use of oxidizing acids. Quite the contrary since Ward '834 is in a non-aqueous medium of polyglycols and operates at near neutral pH. No corrosion inhibitors or "oxidizing agents" are mentioned in Ward '834.

The Examiner is further inventing by bringing in irrelevant material in order to arrive at the present invention. Neither Ward '834 or the present invention teach or suggest the use of rare earth ions.

For reasons previously stated, Ward '834 alone or in combination with Canaperi et al does not amount to the same subject matter of the present invention so that double patenting cannot be an issue.

Ward '834 and the present invention are diametrically opposed to one another.

Canaperi et al is not only irrelevant to Ward '834 but also to the present invention.

The Examiner states "...the slurry of Ward comprises two parts wherein Part A comprises an oxidizing agent and abrasive particles." However, there are no oxidizing agents anywhere in Ward '834. It is further illogical to include an oxidizing agent which is a corrosion enhancer in a formulation that also uses a corrosion inhibitor.

The corrosion inhibitor is included in the present invention because the system is corrosive since it is an ionic aqueous medium. Ward '834 does not mention corrosion

inhibitors since the system is a non-corrosive, non-aqueous medium which distinguishes the inventions.

Consequently, the Examiner further errs that Canaperi et al and Ward '834 are essentially the same. Canaperi et al has no relevance to Ward '834 or the present invention.

In summary, patent no. 6,602,834 does not relate to the same subject matter as the present invention since as illustrated by the reactions disclosed the end results are totally different. Moreover, the present invention relates to an aqueous system while Ward '834 is non-aqueous. Ward '834 relies upon polyelectrolytes to generate particle repulsion by gel slugs which are purely organic in nature. Applicants' suspension particles are inorganic. The metal hydroxide gels of the present invention cannot be formed in the non-aqueous system of Ward '834. Consequently, Ward '834 alone cannot teach or suggest the present invention or form a basis upon which the present claims can apply.

Canaperi et al is neither pertinent to Ward '834 or the presently claimed invention. The Examiner has made up her own chemistry which does not apply to the prior art or the present invention. The Examiner has introduced oxidizing agents into Ward '834 and the present application which do not exist. The Examiner has introduced rare earth ions in Ward and the present invention which do not exist.

The Examiner has introduced an oxidizing agent into Ward '834 which does not exist and has attempted to apply the non-existing oxidizing agent to the present invention.

In the case at hand, the art of record does not provide sufficient teaching which would lead a skilled artisan to arrive at the whole instant invention. The Examiner has failed to demonstrate the whole invention of the applicants was disclosed either alone or

in any combination of teachings of record. It is this lack of teaching which cannot support her allegations, and thus provides patentability to the present invention.

It is applicants' contention that the Examiner is guided to the rejection under obviousness only after knowing applicants' invention and working backward from this knowledge by trying to fit the teachings of the references to the teachings of the applicant.

The Examiner's attention is respectfully directed to the opinion of the Court in In re Novia, 509 F2d 566, 184 USPQ 6079 (CCPA 1975), which stated:

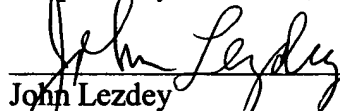
"There must, however, be a reason apparent at the time the invention was made to the person of ordinary skill in the art for applying the teaching at hand, or the use of the teaching as evidence of obviousness will entail prohibited hindsight."

It is well established in the law that "obvious to try" is not a standard. See for example, In re Goodwin, 198 USPQ 1 (CCPA 1978), at 3.

35 USC 103 provides that an invention is not patentable if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to person having ordinary skill in the pertinent art. In the present case the differences are materially and chemically distinguishable.

Reconsideration and favorable action are earnestly solicited

Respectfully submitted,



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